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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THERON TOCK and SAMPATH SRINIVAS

Appeal 2008-002288[1]
Application 09/706,297
Technology Center 2400

Decided: February 2, 2010

Before JEAN R. HOMERE, JAY P. LUCAS, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed November 03, 2000. The real party in interest is Juniper Networks, Inc. (App. Br. 1.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 37. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm in part and enter a new ground of rejection.

Appellants' Invention

Appellants invented a method and system for modifying a script portion of a markup language document to thereby facilitate access to resources residing on a remote server through an intermediary server. (Spec. 3, ll. 2-6.) As shown in Appellants' Figure 1, upon receiving from a client machine (104) a request for contents located at a remote server (110, 112), the intermediary server (108) parses the markup language document associated with the request to locate therein a script containing a link. The intermediary server (108) then modifies the link to reference the intermediate server as the hostname. (Spec. 4, ll. 26-31; 6, l. 26- 7, l. 19.)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

> 1. A method for modifying a markup language document comprising:
>
> receiving the markup language document at an intermediary server, the markup language document having at least one script portion including at least one link to a resource; and
>
> modifying the at least one link within the script portion of the markup language document to link to the intermediary server.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Delph	6,356,934 B1	Mar. 12, 2002
Pettersen	6,826,594 B1	Nov. 30, 2004

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1 through 37 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Pettersen.

2. Claims 1, 10, 16, 17, 20, 21, and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Delph.

Appellants' Contentions

1. Appellants contend that Pettersen does not teach modifying a link within a script portion of a markup language document to link to an intermediary server, as recited in independent claim 1. (App. Br. 9-12, Reply Br. 2-8.) According to Appellants, Pettersen discloses a central website that provides linking information between an affiliate website and merchant websites. (App. Br. 9.) In particular, Appellants argue that after receiving an HTML document, the central website can send additional content to the user at the behest of the affiliate website, and merchant websites can thereafter make changes to the contents of their advertisements. (*Id.* at 11-12.) However, Appellants contend that the cited disclosure does not teach the modifying a link within a script of the received HTML

document to link with either the central website or the affiliate website. (*Id.* at 12.)

2. Appellants also contend that Delph does not teach modifying a link within a script portion of a markup language document to link to an intermediary server, as recited in independent claim 1. (App. Br. 52-54, Reply Br. 59-60.) According to Appellants, Delph discloses an intermediate server that edits HTML data by identifying and modifying weblinks therein to point to the intermediate server. (*Id.*) However, Appellants contend that the cited disclosure does not teach that the modified a link is within a script of the received HTML document. (*Id.*)

Examiner's Findings

1. The Examiner finds that Pettersen's disclosure of an affiliate server that sends a request to a central server to modify a link within a script of an HTML document teaches modifying a link within an HTML document to link to an intermediary server. (Ans. 9.)

2. The Examiner finds that Delph's disclosure of modifying a common scripting language in URLs within the HTML document teaches modifying the link within a script in the HTML document. (*Id.* at 12.)

II. ISSUE

Have Appellants shown that the Examiner erred in finding that both Pettersen and Delph teach modifying a link within a script portion of a markup language document to link to an intermediary server, as recited in independent claim 1?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence:

Pettersen

1. Pettersen discloses a method and system for inserting dynamic content from a web server into a designated portion of a webpage to thereby generate a webpage with dynamic content in response to a client's request to a host computer to access the webpage. (Col. 4, ll. 2-6, ll. 49-57.)

2. As shown in Figure 11, Pettersen discloses that a user at the affiliate website (790) can contact the content serving website (780) that uses a web server (781) to remotely manage the contents of various webpages, and to modify the contents for insertion into pre-designated zones (smart zones) of the webpages (793) in the affiliate website. (Col. 7, ll. 1-11.)

3. The content serving website (780) includes a content database (785) that contains a plurality of modifiable indexed entries associated with interpretable JavaScript. (Col. 7, ll. 12-34.)

4. After defining smart zones in a webpage of the affiliate website (790) by embedding therein dynamic content codes, the webpage owner accesses the content database at the content serving website (780) to identify contents to be dynamically inserted into the smart zones. The affiliate webpage owner can only alter authorized entries in the content database. (Col. 7, ll. 47-65.)

5. Upon initiating the dynamic content code, which includes a link within a script that identifies a host server code, a program filename, and an identification code, the affiliate webpage associated therewith is retrieved along with the associated contents from the content serving website to modify the affiliate webpage as indicated by the webpage owner. (Col. 8, ll. 1-42.)

6. After modifying the affiliate webpage, the content serving website returns a modified link to the affiliate owner reflecting the modified webpage. (Col. 8, ll. 6-29.)

7. Pettersen discloses scanning the received HTML code, parsing it to identify different script portions, and subsequently retrieving an output for a calling webpage. (Col. 9, ll. 10-20.)

Delph

8. As depicted in Figure 1, Delph discloses upon receiving a URL from a sender computer (80) requesting access to certain HTML document located at a content server (70), an intermediate server (50) retrieves the requested HTML document from the content server (70). Then, a control program running on the intermediate server (50) may instruct it to modify web links within the HTML document to point back to the intermediate server (50). (Col. 5, ll. 21-41.)

9. Delph further discloses that modified web links displayed on the sender screen (85) display leads back to the intermediate server (50), whereas unmodified web links lead directly to the content server (70) that has the identified data. (Col. 6, ll. 6-16.)

Appellants' Specification

10. Appellants' Specification indicates that examples of a computer readable medium include carrier waves. (Spec. 43, ll. 2-4.)

IV. PRINCIPLES OF LAW

Anticipation

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted)).

"Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citation omitted). "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." *Id.* (citation omitted).

V. ANALYSIS

1. *Pettersen*

Independent claim 1 requires, in relevant part, modifying a link within a script portion of a markup language document to link to an intermediary server. (App. Br. 66, Claims App'x.)

As set forth in the Findings of Fact section, Pettersen discloses that upon an affiliate owner sending a link within a script to a remote website to modify certain pre-designated zones within an associated webpage, the remote website returns a modified link with the requested modifications to the affiliate owner to subsequently render on a display device the webpage associated therewith. (FF. 1-7.) We find that the web server in Pettersen's content serving website is an intermediary server that modifies a received link of an HTML script to thereby insert specified contents into an associated webpage which is sent to the affiliate website. Consequently, the modified link received from the web server is linked to an intermediary server. It follows that Appellants have not shown that the Examiner erred in finding that Pettersen anticipates independent claim 1.

Regarding Appellants' arguments presented at pages 12 through 52 of the Appeal Brief and pages 2 through 52 of the Reply Brief, we observe the following for most of claims 2 through 37:

(1) Appellants reproduce the language of the claim;

(2) Appellants argue that the cited claim is not anticipated by Pettersen based on the same arguments for patentability submitted for claim 1 above;

(3) Appellants reproduce the text upon which the Examiner relies for the rejection;

(4) Appellants provide a brief explanation of the cited text, and/or

(5) Appellants make a general allegation that the cited text does not teach the cited claim language.

A. In response, we make the following remarks:

1) We addressed Appellants' argument regarding the limitations of claim 1, and we found that Pettersen anticipates claim 1.

2) Appellants are reminded that a statement that merely points out what the claim recites will not be considered as an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). Appellants are further reminded that a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not constitute a persuasive response. 37 C.F.R. § 1.111(b).

B. Further, we find the following:

1) Pettersen's disclosure of the web server delivering the modified link to the affiliate owner (FF. 6) teaches the disputed limitations of claim 2. We will sustain the Examiner's anticipation rejection against this claim.

2) While Pettersen discloses that the web server modifies the received link, and forwards it to the owner at the affiliate website, (FF 2) we find that such disclosure does not lend itself to replacing the located hostname with a replacement host name, as recited in claims 4 through 8, 24 through 28, and 37. Therefore, we will not sustain the Examiner's anticipation rejection against these claims.

3) We found in our discussion of claim 1 that Pettersen teaches modifying the link within a script to link to a server. *See supra* p. 7-8. Further, we find that Pettersen's disclosure of an affiliate issuing a string call

to dispatch a link to the web server for subsequent modification (FF. 5) teaches the disputed limitations of claim 10. Therefore, we will sustain the Examiner's anticipation rejection against this claim.

4) Pettersen's disclosure of scanning the script in a received HTML document to modify the received script with content data stored in the content database as indicated by the affiliate owner, and to subsequently return the modified link to the affiliate (FF. 4-7) teaches replacing the predetermined function with a statement call, as recited in claims 11 through 19. Therefore, we will sustain the Examiner's anticipation rejection against these claims.

5) Regarding claims 20 through 23, 30, and 32-36, Appellants reiterate the same arguments previously raised for the claims discussed above. Further, Appellants have not presented separate arguments for claims 3, 9, 29, and 31. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), these claims will fall with their corresponding claims with similar limitations discussed above.

2. *Delph*

As per claim 1, we find that Delph's disclosure of a control program instructing an intermediate server to modify web links associated with the retrieved HTML documents (FF. 8) teaches the disputed limitations. In particular, we find that the disclosed control program is a script since it is a set of instructions that direct the intermediate server to modify the web links associated the retrieved documents. Further, as per claim 17, we find the

instructions sent between the sender, intermediate server and content server are function calls that the control program uses to enable the different devices on the network to communicate with one another. Therefore, we will sustain the Examiner's anticipation rejection against claims 1 and 17.

Regarding claims independent claims 10, 16, 20, 21 and 35, Appellants reiterated the same arguments previously raised for the claims discussed above. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), these claims will fall with corresponding claims with similar limitations discussed above.[2]

VI. NEW GROUND OF REJECTION

35 U.S.C. § 101 Rejection

Claims 20 through 37 recite, in relevant part, "[a] computer readable media including at least computer program code." (App. Br. 69-74, Claims App'x.)

According to Appellants' Specification, computer readable media includes carrier waves. (FF. 10.) We find that such transmissions implicate a carrier wave or a signal modulated by a carrier over a transmission medium. Therefore, the cited claims encompass the use of a computer data signal embodied in a carrier wave to transmit information. A computer data signal embodied in a carrier wave is a transitory, propagating signal not

[2] We note that FF. 9 above appears to teach the limitations of dependent claim 4 and the like. We leave it to the Examiner to decide whether to reject those claims based on Delph's disclosure.

within any of the four statutory categories and, therefore, non-statutory. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). It follows that claims 20 through 37 are directed to non-statutory subject matter.

VII. CONCLUSIONS OF LAW and DECISION

1. Appellants have not established that the Examiner erred in rejecting claims 1 through 3, 9 through 23, and 29 through 36 as being anticipated under 35 U.S.C. § 102(e) by Pettersen. We therefore affirm the Examiner's rejection of these claims.

2. Appellants have not established that the Examiner erred in rejecting claims 1, 10, 16, 17, 20, 21, and 35 as being anticipated under 35 U.S.C. § 102(e) by Delph. We therefore affirm the Examiner's rejection of these claims.

3. Appellants have established that the Examiner erred in rejecting claims 4 through 8, 24 through 28 and 37 as being anticipated under 35 U.S.C. § 102(e) by Pettersen. We therefore reverse the Examiner's rejection of these claims.

4. We have entered a new ground of rejection against claims 20 through 37 as not being directed to statutory subject matter under 35 U.S.C. § 101.

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
> (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

nhl

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